

AF GP3723

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March 29, 2000

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Re: Snap-on Technologies, Inc.
File 14,281B
Patent Application for:
MAGNETIC BIT HOLDER AND HAND
TOOL INCORPORATING SAME
Serial No. 09/110,145

RECEIVED
APR -4 2000
TECHNOLOGY CENTER 3700

Sir:

Transmitted herewith for filing is a Request for Reconsideration and certified copy of Amended Letters of Special Administration in the above-captioned application, sent with Certificate of Mailing thereon.

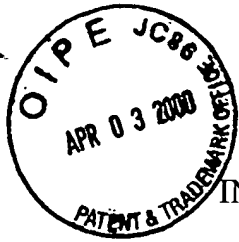
No additional fee is required.

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Sincerely yours,


J. Terry Stratman

JTS:if



PATENT

(NE)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#7/Reg 609
4/17/00

Applicants: Daniel M. Eggert et al.

Title: MAGNETIC BIT HOLDER AND HAND
TOOL INCORPORATING SAME

Serial No.: 09/110,145 ✓

Filing Date: July 2, 1998 ✓

Group Art Unit: 3723

Examiner: D. Meislin

Date: March 29, 2000

CERTIFICATE OF MAILING

I hereby certify that this correspondence
is being deposited with the United States
Postal Service as first class mail in an
envelope addressed to: Assistant Commissioner
of patents, Washington, D.C. 20231 on

3/29/00

Date of Deposit

Daniel M. Eggert et al.
Signature

3/29/00

Date of Signature

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APR -4 2000

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Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

REQUEST FOR RECONSIDERATION

Sir:

This is in response to the Office Action dated February 9, 2000. Reconsideration of the rejected claims is respectfully asked.

Submitted herewith is a certified copy of the Amended Letters of Special Administration, appointing Daniel Garramone as a legal representative of the deceased inventor, Frank Mikic. This constitutes the proof of authority of Mr. Garramone as legal representative for Mr. Mikic.

A Supplemental Reissue Declaration pursuant to 37 C.F.R. §1.175(b)(1) was forwarded to the Office on January 20, 2000 and apparently crossed in the mail with the outstanding Office Action.

It is noted, with appreciation that claims 1-14 have been allowed.

Claims 15-22 are finally rejected under 35 U.S.C., §251 as constituting an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. The examiner asserts that the broadening aspect constitutes omission in the reissue OF the limitation “retaining member being generally bowl-shaped and convex toward said magnet,” which the examiner contends is related to subject matter surrendered in the original application.

The examiner acknowledges the statement in *In re Clement* (45 USPQ2d 1641) that, if an applicant amends a broad claim in an effort to distinguish a reference and obtain allowance but promptly files a continuation application to continue to traverse the prior art rejection, this is evidence that the applicant did not admit that broader claims were not patentable. However, the examiner contends that this statement does not apply to applicants’ filing of the divisional application (serial no. 593,396, now U.S. Patent no. 5,603,248), presenting claims which omitted the “bowl-shape and convex toward said magnet” limitation, since that divisional application was directed to “a species different from the parent application.” Thus, the examiner concludes that “The Divisional application is

directed to an invention other than that prosecuted in the parent application.” Assuming, *arguendo*, that the examiner’s interpretation of *In re Clement* is correct, it is submitted that the rejection is still in error because the examiner reads too broadly the scope of the subject matter “surrendered” in the original application.

The rejection is based on the absence from the reissue claims 15-22 of the limitation “retaining member being generally bowl-shaped and convex toward said magnet,” which was added in the parent application. Thus, the examiner’s position is based on the assumption that applicants surrendered all retaining members except those which are “generally bowl-shaped and convex toward said magnet.” But the scope of the subject matter surrendered cannot be determined by simply looking at the language of the limitations added to the claim. Rather, one must also look to the language of the claim **before amendment** and the scope of the prior art being distinguished. The reason why amendment of a claim to overcome a reference is relevant, is that it constitutes evidence “that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable.” (*In re Clement*, 45 USPQ2d at 1164). The claim before amendment by addition of the “bowl-shaped and convex” language was silent as to the size or shape of the retaining member. **That**, i.e., a retainer unlimited as to size or shape, is the subject matter which was surrendered, and applicants are making no attempt in this reissue to recapture that subject matter.

Amendment of the claim was necessary because the prior art included a retaining

member having a particular size and shape, i.e., the split-ring retainer of Parsons et al. patent no. 4,463,998. There are various ways to distinguish from that reference. One was by addition of the “bowl-shaped and convex” language added in the original application, and which was ultimately allowed. Another was recitation of a “discrete, flat, imperforate retaining member,” as in the divisional, which was also allowed. A third approach is that pursued in rejected claim 15 herein, which recites a retaining member “substantially covering said outer surface of said magnet.” It is clear from the foregoing that applicants did not surrender all retaining members which were not “bowl-shaped and convex toward said magnet.” Rather, applicants surrendered only the specific split-ring retaining shape of Parsons et al. and the claim scope before it was amended, i.e., a retaining member unlimited as to size and shape. Applicants’ amendment to overcome the rejection constituted evidence that those subjects matter were surrendered as unpatentable, but neither of those subjects matter is being pursued in this reissue application. The Amendment did not constitute a surrender of the subject matter of claims 15-22 and, therefore, the recapture rule does not afford a valid basis for rejection of those claims.

This conclusion can also be tested by comparing rejected claim 15 with claims canceled from the original application as to their relative scope. This test was spelled out in *In re Clement*, which distilled it from the prior decisions, including the *Ball* case. The examiner “prefers to not cloud the issue by discussing whether a claim which omits one

limitation and adds another limitation should be construed as being a ‘broader or narrower claim,’” but the *In re Clement* test does not require that the reissue claim be characterized as either “broader” or “narrower” than other claims. Rather, the *In re Clement* decision specifically addresses the situation of the present case, wherein the reissue claim is both broader and narrower, i.e., “broader in some respects, but narrower in others,” than claims canceled from the original application. (45 USPQ2d at 1165). In that situation, the court held that:

”If the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim....” (45 USPQ2d at 1165).”

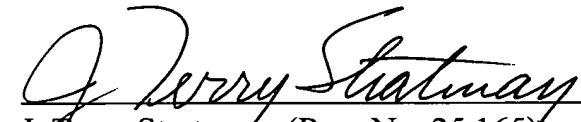
As was explained in the preceding amendment, the respects in which reissue claim 15 is broader than original application claim 1 are not germane to the prior art rejection, since none serves to distinguish over the prior art and none was ever relied upon to distinguish over the prior art. However, claim 15 is narrower in a respect directly related to the rejection, i.e., it defines a specific size and shape of the retaining member which distinguishes from the Parsons et al. patent. This serves to confirm that applicants are not trying to recapture previously surrendered subject matter.

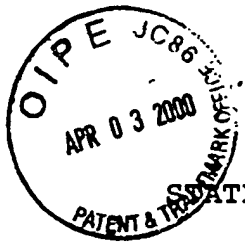
This result is entirely logical. The recapture rule is intended to prevent an applicant from having his cake and eating it too. By giving up a claim scope in the face of a rejection and then, by reissue, trying to again pursue the same claim scope. But as long as an applicant

is not attempting to resurrect in reissue a claim scope which was effectively canceled in the original application, and otherwise adheres to the reissue rules, there is no reason why he should not be able to pursue any claim supported by the original disclosure which distinguishes from the prior art. In view of the foregoing, it is respectfully requested that the rejection of claims 15-22 on the basis of the recapture rule be reconsidered and withdrawn.

It is also respectfully asked that applicants be advised of the disposition of this request before the expiration of the three-month statutory response period on May 9, 2000.

Respectfully submitted,


J. Terry Stratman (Reg. No. 25,165)
Harold V. Stotland (Reg. No. 24,492)



STATE OF WISCONSIN

CIRCUIT COURT
PROBATE

WALWORTH COUNTY

In the Matter of the Estate of

FRANK MIKIC,

Deceased.

AMENDED LETTERS OF
SPECIAL ADMINISTRATION

File No. 95-PR-343

TO: Snap-On Technologies, Inc., whose representative is
Daniel Garramone.

The above-named person died, domiciled in Walworth County,
Wisconsin, on November 28, 1995.

You have been appointed special administrator of the estate
and have fully qualified.

THEREFORE, these amended Letters are issued to you, and you
are ordered to administer this estate and granted the following
powers:

Limited to making certain oaths or declarations, or to
perform certain other tasks, with respect to patents or
patent applications associated with inventions of Mr. Frank
Mikic;

SEAL

BY THE COURT:

Gloria Niemetscheck

~~Circuit Judge~~

11-17-98

Date

Gloria Niemetscheck-Register in Probate
Wis. Stats. S757.69 (1) (e) & 757.72 (5)

Mark A. Shiller (#1024008)
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414-277-5000

FILED

WALWORTH COUNTY

NOV 17 1998

GLORIA NIEMETSCHKE
REGISTER IN PROBATE